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Response to May 26, 2005 Final Office Action

REMARKS/ARGUMENTS

Claims 1-34 are pending. No claims have been amended, canceled, or added.

As a preliminary matter, Applicant appreciated the opportunity to discuss the pending claims with the Examiner during the July 13, 2005 telephone interview. This Request for Reconsideration is a result of that interview. During the interview, and as a result of new understanding gained during the interview, the Examiner agreed with Applicant that the pending claims are not anticipated by U.S. Patent Application no. 5,740,549 to Reilly et al ("Reilly"). The Examiner also indicated that responsive to receipt of this Request for Reconsideration, the finality of the final Office action would be withdrawn.

Accordingly, in view of the above and in view of the following remarks/arguments, withdrawal of the finality of the final Office action and withdrawal of the outstanding rejections to the pending claims is respectfully requested.

Claim Rejections Under 35 USC §102(b)

Claims 1-34 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent Application no. 5,740,549 to Reilly et al ("Reilly"). These rejections are traversed.

Claim 1 recites "receiving, by the server computer, a request from the client computer for one or more requested content items", and "responsive to receiving the request: identifying, by the server computer, a data structure that refers to one or more further content items; modifying, by the server computer, the data structure to reference the requested content items; and providing, by the

server computer, the content items referenced by the modified data structure to the client computer." Reilly does not describe these features.

Reilly at column 14, line 18, through column 16, line 35, clearly discloses that a client computer sends a message including a user profile to a server. Based on this user profile, the server determines whether a news item or an administrative update is to be performed, what new information is to be downloaded to the client computer, and what information is to be deleted from the client computers local information database. Reilly explicitly describes that "[t]he application server 272 then makes calls to one or more data servers 274 **to collect all the information that needs to be sent to the client computer and then sends those items to the client computer,** along with instructions on what items, if any, should be deleted from the client computers local information database" [emphasis added]. Reilly at column 15, lines 7-40, clearly discloses that after a client receives requested items from the server, the client "loads the received information into its local database, and replaces software modules with received software modules, if any. It also deletes the items, if any, specified for deletion by the information server. Finally, it updates its data access tables 186 to incorporate all the changes to the information database so that the client computer is ready to display news items and advertisements in each information category."

In view of the above, and instead of referencing content in a data structure, the server of Reilly actually collects all of the information (e.g., news stories, advertisements, software updates, etc.) that needs to be sent to the client computer, stores the collected information into the information database, and then sends the collected items to the client computer. Storing actual data files in an information database instead of merely referencing the data files in the database is not the same

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thing as "modifying, by the server computer, the data structure to reference the requested content items", as claim 1 recites. One reason for this is because referencing requested content in a data structure does not modify the data structure with the actual data being referenced. Thus, a system of Reilly may never "receiving, by the server computer, a request from the client computer for one or more requested content items", and "responsive to receiving the request: identifying, by the server computer, a data structure that refers to one or more further content items", and "modifying, by the server computer, the data structure to reference the requested content items", as claim 1 recites.

The Action at page 6 also asserts that the *claim language* of Reilly at column 17, lines 24-38, describe the step of modifying, by the server computer, a data structure to reference the requested content items. However, it is respectfully submitted that the scope of a patent's claim determines what infringes that patent, not what the cited claim language discloses. Determining scope of claim language is a matter of law, and not a task typically undertaken by an applicant during the patent application prosecution stage. In view of this, and in view of the already discussed clear disclosure of Reilly, it is plain that the detailed description of Reilly does not teach any such operation, and without teaching each and every element of a claim, as set forth in the claim, there can be no anticipation.

For each of the above reasons, and for the reasons clearly described in the March 11, 2005 Response, Reilly does not describe each and every element of claim 1 as set forth in claim 1. If a reference does not teach each and every element of a claim, and as set forth in the claim, then no anticipation can be found.

Accordingly, withdrawal of the 35 USC §102(b) rejection of claim 1 is respectfully requested.

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Claims 2-9 depend from claim 1 and are not anticipated by Reilly solely by virtue of this dependency. Accordingly, withdrawal of the 35 USC §102(b) rejection of claims 2-9 is respectfully requested.

Moreover, claims 2-9 include additional features that are not anticipated by Reilly. For example, claim 2 recites "wherein identifying the data structure, the data structure comprises a playlist", "wherein receiving the request, the one or more requested content items comprises streaming media content", and "wherein providing the content items further comprises streaming the content items referred to by the playlist." In addressing claim 2, the Action on page 5 asserts that Reilly describes such a "playlist" in col. 7, lines 7-12, and that "Examiner interprets the category and sub space category corresponds to a play list". However, for the reasons already discussed in the July 13, 2005 telephone interview, as well as for the reasons presented in the March 11, 2005 Response, the cited section is completely silent with respect to any "playlist". It is well known that a playlist references streaming media content such as video and/or audio. Playlists do not normally contain the actual media data, but rather particular references (i.e., a URL) to stored media data. Reilly as a whole is completely silent with respect to any such "playlist", as Applicant claims.

Rather than describing "a playlist", Reilly clearly discloses what "information categories" and "sub-categories" are. Reilly at col. 9, lines 35-57, clearly discloses that information categories include, for example, "the Sports category", from which "the user can select and deselect subcategories of sports information". Reilly clearly discloses that such a sub-category related to "the Sports category" would be "49ers, Rams", which can also be included in the "'football news' subcategory". Reilly at col. 7, lines 7-12, describes that

"[s]ubcategories may relate to specific companies, geographic regions, specific sports and sports teams, and so on, depending on the category."

Clearly, Reilly's information categories and subcategories used to categorize a user's interest in receiving news items, do not explicitly, or inherently, describe "a playlist", as Applicant claims. If a reference does not teach a claimed element, then no anticipation can be found.

For each of the above additional reasons, withdrawal of the 35 USC §102(b) rejection of claim 2 is respectfully requested.

Claim 2 also recites "wherein receiving the request, the one or more requested content items comprises streaming media content". In addressing this feature, the Action asserts that "Reilly's 'news feed from information transmission ... AP news feed...' is equivalent to applicant use of the phrase 'streaming media'". Applicant respectfully disagrees. Nowhere does Reilly describe client 102 sending a request for "streaming media content". Reilly as a whole does not even mention "streaming media content", as claim 2 recites. It is well known that streaming media is streaming video with sound and/or streaming audio. With streaming video or streaming media, a user does not have to wait to download a large file before seeing the video or hearing the sound. Instead, the media is sent in a continuous stream and is played as it arrives. In contrast, Reilly explicitly describes client requested information must be completely downloaded to the client before the client can access that information.

More particularly, Reilly explicitly describes that "[t]he application server 272 then makes calls to one or more data servers 274 **to collect all the information that needs to be sent to the client computer and then sends those items to the client computer**, along with instructions on what items, if any,

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should be deleted from the client computers local information database" [emphasis added]. Reilly at column 15, lines 7-40, clearly discloses that **after a client receives requested items from the server, the client "loads the received information into its local database, and replaces software modules with received software modules, if any**. It also deletes the items, if any, specified for deletion by the information server. Finally, it updates its data access tables 186 to incorporate all the changes to the information database so that the client computer is ready to display news items and advertisements in each information category" [emphasis added].

In view of the above explicit description of Reilly, it is clear that Reilly's delivery of news items to a client does not explicitly or inherently describe any streaming media content. Again, if a reference does not teach the claimed element, then no anticipation can be found. Thus, a system of Reilly cannot anticipate "wherein receiving the request, the one or more requested content items comprises streaming media content".

For these additional reasons, withdrawal of the 35 USC §102(b) rejection of claim 2 is respectfully requested.

In another example, claim 3 recites "the data structure comprises a **first Web page specification**, and the requested content comprises a **second Web page specification**" [emphasis added]. For the reasons already discussed in the March 11, 2005 Response, nowhere does Reilly explicitly or inherently describe such "requested content". For these additional reasons, withdrawal of the 35 USC §102(b) rejection of claim 3 is respectfully requested.

In another example, claim 7 recites "the data structure further comprises a placeholder that identifies a particular point in a sequence where the reference to

the requested content is placed." As discussed above with respect claim 1, "the reference" is not the actual content referred to by the reference, and Reilly merely describes downloading actual content and storing the actual content (e.g., news items, advertisements, software updates, etc.) into an information database. Nowhere does this explicitly or inherently describe anything that "identifies a particular point in a sequence where the reference to the requested content is placed". For these additional reasons, withdrawal of the 35 USC §102(b) rejection of claim 7 is respectfully requested.

In another example, claim 8 recites "creating the data structure by modifying a base data structure." Although Reilly describes downloading requested content into a information database of limited size (a function of the amount of available secondary memory), Reilly does not explicitly or inherently describe "creating the data structure by modifying a base data structure", as Applicant claims. For these additional reasons, withdrawal of the 35 USC §102(b) rejection of claim 8 is respectfully requested.

In another example, claim 9 recites "creating the data structure by copying a base data structure." For the reasons already discussed above with respect to claim 8, and for the reasons presented in the March 11, 2005 Response, Reilly does not explicitly or inherently describe these claimed features. For these additional reasons, withdrawal of the 35 USC §102(b) rejection of claim 9 is respectfully requested.

Claim 10 recites "receiving, by a server computer, a request that refers to one or more streaming media content items", "identifying, by a server computer, a playlist that refers to a sequence of one or more further streaming media content items" modifying, by a server computer, the playlist to reference the one or more

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requested streaming media content items in the sequence", and "streaming, by a server computer, the streaming media content items referenced by the modified playlist to at least one requesting client computer."

Reasons why Reilly does not anticipate the features of claim 10 have already been discussed above with respect to claim 1. For at least these reasons, the 35 USC §102(b) rejection of claim 10 as anticipated by Reilly is improper and should be withdrawn.

Claims 11-16 depend from claim 10 and are not anticipated by Reilly solely by virtue of this dependency.

Accordingly, the 35 USC §102(b) rejections of claims 11-16 are improper and should be withdrawn.

Moreover, for the reasons already discussed with respect to claims 2-9, claims 11-16 include additional features that are not anticipated by Reilly. For these additional reasons, the rejections of claims 11-16 should be withdrawn.

Claim 17 recites "receiving, by a server computer, a request from a client computer for one or more requested Web documents" and "responsive to receiving the request: identifying, by a server computer, a wrapper Web document that refers to one or more further Web documents; modifying, by a server computer, the wrapper Web document to reference the one or more requested Web documents; and providing, by a server computer, the Web documents referenced by the modified wrapper Web document to the client." For the reasons already discussed above, Reilly does not anticipate these claimed features.

Moreover, Reilly is completely silent with respect to any "wrapper Web document". The only support in Reilly for a Web page provided by the Action describes "'clicking' on the advertisement to connect to the advertiser's World

Wide Web page". Clearly, this does not describe "identifying, by a server computer, a wrapper Web document that refers to one or more further Web documents", as Applicant claims.

At least for those reasons, the 35 USC §102(b) rejection of claim 17 as anticipated by Reilly is improper and should be withdrawn.

Claims 18-23 depend from claim 17 and are not anticipated by Reilly solely by virtue of this dependency.

Accordingly, the 35 USC §102(b) rejections of claims 18-23 are improper and should be withdrawn.

Moreover, for the reasons already discussed with respect to claims 2-9, claims 18-23 include additional features that are not anticipated by Reilly. For these additional reasons, the rejections of claims 18-23 should be withdrawn.

Claim 24 recites "receiving a plurality of requests from a client for one or more requested content items", "responsive to receiving the request, and for at least a subset of the received requests: (a) identifying, by the server, a data structure containing a sequence of references to one or more further content items; (b) modifying, by the server, the data structure reference to the requested content items; and (c) communicating, by the server, the content items referenced by the modified data structure to the client." Reasons why Reilly does not anticipate these claimed features were already discussed above with respect to claim 1. At least for those reasons, the 35 USC §102(b) rejection of claim 24 as anticipated by Reilly is improper and should be withdrawn.

Claims 25-31 depend from claim 24 and are not anticipated by Reilly solely by virtue of this dependency.

Accordingly, the 35 USC §102(b) rejections of claims 25-31 are improper and should be withdrawn.

Moreover, for the reasons already provided with respect to claims 2-9, claims 25-31 include additional features that are not anticipated by Reilly. For these additional reasons, the rejections of claims 25-31 should be withdrawn.

Claim 32 recites "one or more first data fields, each data field containing data therein **representing a respective reference to a set of content items**", "at least one second data field containing data therein representing a respective placeholder to identify a particular point in a sequence of the one or more first data fields where a reference to a set of client requested content is to be inserted", and wherein the data structure is a playlist or a Web page" [emphasis added]. Nowhere does Reilly describe each of these claimed features. For instance, in addressing claim 32, the Action asserts that Fig. 8 of Reilly describes "at least one second data field containing data therein representing a respective placeholder to identify a particular point in a sequence of the one or more first data fields where a reference to a set of client requested content is to be inserted", as claimed. Applicant disagrees.

Reilly at col. 2, lines 51-54, col. 12, lines 15-22, and col. 11, lines 64-66, respectively describe:

"FIG. 8 and 9 schematically depict data structures stored in a subscriber's computer to indicate advertisements and news stories available for display in various information categories."

As shown in FIGS. 8 and 9, the advertisements assigned to each information category are organized, through the use of a set of data access tables 186, in a separate linked list so as to create a separate "queue" of advertisements for each information category. Similarly the news items and display scripts assigned to each information

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> *category are organized in separate linked lists so as to generate separate queues of news items and display scripts for each information category."*

And,

> *"[r]eferring to FIG. 8, news stories, advertisements and display scripts are stored in files or similar data structures which have assigned unique file names."*

Clearly, the data structure Reilly describes in reference to Fig. 8 uses tables and liked lists to identify files that contain material for presentation on a subscriber's computer. This cited description does not explicitly or inherently describe that the data structure of Fig. 8 includes any "placeholder" identifying where "a set of client requested content is to be inserted," especially wherein "the data structure is a playlist or a Web page", as claim 32 recites.

With respect to the claimed "playlist", the Action asserts on page 7, in reference to the rejection of claim 33, that Fig. 5 of Reilly shows the claimed "playlist". This conclusion is unsupportable. Reilly explicitly describes at col. 3, lines 43-44, that "FIG. 5 schematically depicts the dialog box used to define the user profile for one information category." For the reasons already discussed above with respect to claim 1, a dialog box is not a "playlist". Thus, a system of Reilly may never include a "wherein the data structure is a playlist".

Additionally, and with respect to "wherein the data structure is a [...] web page", the Action asserts on page 7, in reference to the rejection of claim 34, that Reilly at col. 13, lines 9-14 describe the claimed "wherein the data structure is a [...] web page". This conclusion is also unsupportable. Reilly explicitly describes at col. 13, lines 9-14, that:

> *"When using the second screen saver exit mode, if subscriber user clicks on an advertisement, the subscriber's computer is automatically connected to the an associated World Wide Web page on the Internet that provides additional information from the advertiser. This is accomplished by World Wide Web connection and viewer procedures 211".*

Clearly, Reilly at col. 13, lines 9-14 merely describes that a user can browse to a Web page by clicking on an advertisement. A description of browsing Web pages and clicking on advertisements does not explicitly or inherently describe "one or more first data fields, each data field containing data therein representing a respective reference to a set of content items", "at least one second data field containing data therein representing a respective placeholder to identify a particular point in a sequence of the one or more first data fields **where a reference to a set of client requested content is to be inserted", and wherein the data structure is a playlist or a Web page"** [emphasis added], as claim 32 recites.

For each of the above reasons, Reilly does not describe each and every element of claim 32. Thus, Reilly does not anticipate claim 32.

Accordingly, withdrawal of the 35 USC §102(b) rejection of claim 32 is respectfully requested.

Claims 33 and 34 depend from claim 32 and are not anticipated by Reilly at least by reason of this dependency. Accordingly, the 35 USC §102(b) rejection of claims 33 and 34 should be withdrawn.

Additionally, these claims include additional subject matter that is not described by Reilly. For example, claim 34 recites "wherein the content items are **a first set of Web page specifications**", and "wherein the client requested content are one or more **second Web page specifications**" [emphasis added]. For the

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reasons already discussed above with respect to claim 3, Reilly does not anticipate these claimed features.

For this additional reason, the 35 USC §102(b) rejection of claim 34 should be withdrawn.

Conclusion

Claims 1-34 are in condition for allowance and action to that end is respectfully requested. Should any issue remain that prevents allowance of the application, the Office is encouraged to contact the undersigned before issuing an advisory action.

Respectfully Submitted,

Dated: 7/20/ 2005   By: _____

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